THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI OYAMADA, HIROYUKI KOIDE,
GOH OGINO and HIDEO HIRASAWA

Appeal No. 1997-0845
Application 08/284,902

On Brief

Before PAK, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 and 2 as amended subsequent to the final rejection.[1]

We have carefully considered the record before us, and based thereon, find that we cannot sustain either of the grounds of rejection of the appealed claims under 35 U.S.C. § 103 over Powers

[1] Amendments of June 10, 1996 (Paper No. 6) and June 25, 1996 (Paper No. 9)..

when taken with Walker or over Walker alone.[2] It is well settled that in order to establish a *prima facie* case of obviousness, "[b]oth the suggestion and the expectation of success must be found in the prior art and not in the applicant's disclosure." *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531(Fed. Cir. 1988). Thus, a *prima facie* case of obviousness can be established by showing that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *Dow Chemical*, *supra*.

Appealed claim 1 requires setting the middle burner of a prior art apparatus used to prepare a porous silica glass preform of a double-core optical fiber "at such a position that the extension of the nozzle axis thereof does not intersect with the axis of rotation of the growing porous silica glass body with a displacement distance defined by the value X/D which is in the range from 0.01 to 0.5" while "the extension of the nozzle axis of each of the lowermost and uppermost burners intersecting with the axis of rotation of the growing porous silica glass body." The position taken by the examiner in both grounds of rejection is based on his finding with respect to Walker that

> [h]aving two burners which intersect at 90 degrees and interacting [as taught in Walker (col. 2, lines 65-68)] could not result in having both burners intersecting the axis of rotation; this is because as the fiber preform grows, there would be no interaction between the two burners if they did intersect the axis. See the enlarged version of Walker figure 2 which shows a X/D ratio near 0.32. [Answer, page 5; see also pages 8-9.]

Appellants submit that while Walker

> states that the [burners] should be close enough so that the flames of the adjacent [burners] interact near the surface . . . (col. 4, lines 64-66)[,] [t]his does not necessarily mean that the axes of the [burners] do not intersect the axis of rotation . . . . The attempted projection of Fig. 2 . . . is not relevant since this figure doe not purport to be dimensionally accurate.

[2] Powers and Walker are cited at page 3 of the answer.

> Consequently, the Examiner's attempted extrapolation as to whether there is, in fact, any displacement of the burners from interception of the axis of rotation of the growing body has no basis in fact and cannot, indeed, be derived from the drawings or the description in this reference. [Brief, page 7.]

Upon carefully reviewing the record, we must agree with appellants that the examiner has failed to make out a *prima facie* case of obviousness of the claimed invention as a whole as encompassed by the appealed claims. It is well settled that in evaluating the teachings of a reference, we must consider the specific teachings thereof and the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom. *See, e.g., In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). We find that the examiner has not provided evidence and/or scientific reasoning in the record explaining why one of ordinary skill in this art would have reasonably inferred from the disclosure of Walker as a whole, that is, the specification *and* figures thereof, the alleged teaching that burners should be set "at such a position that the extension of the nozzle axis thereof does not intersect with the axis of rotation of the growing porous silica glass body" as required by claim 1. We find no reasonable basis for such an inference in the cited disclosure of Walker. Indeed, while it appears from Walker Fig. 2 that the nozzle axes of the two burners intersect at a point other than the axis of rotation of the workpiece, it is not apparent that one of ordinary skill in this art would have reasonably inferred from this illustration that the nozzle axis of one or more burners should be offset from the axis of rotation when considered in view of the absence of any direction to do so in the specification and the intersection of the burner nozzle axes at the axis of rotation of the workpiece in Walker Figs. 6 and 7.

Thus, it is manifest that the only direction to appellants' claimed invention as a whole on the record before us is supplied by appellants' own specification.

The examiner's decision is reversed.

Reversed

CHUNG K. PAK	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

Jules E. Goldberg
Mcaulay Fisher Nissen Goldberg and Kiel
261 Madison Avenue
New York, NY 10016